

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/664,560
Inventors : Deason, et al.
Filed : September 17, 2003
Art Unit : 1782
Examiner : Jill M. Gray
Docket No. : 9364
Confirmation No. : 4599
Customer No. : 27752
Title : MULTI-PLY PRODUCTS COMPRISING A
CONSUMER ACCESSIBLE TAB

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Please find Appellants' Appeal Brief relating to an appeal from the August 5, 2010, final rejection (the "Final Rejection") in the above-identified application (the "Subject Application"). The Notice of Appeal was filed electronically with the United States Patent and Trademark Office on October 18, 2010, and was noted as received on the same date.

The Director is hereby authorized to charge all required fees (including any extension of time fees) and to credit any overpayments in this and any concurrent or future correspondence to Deposit Account No. 16-2480.

REAL PARTY IN INTEREST

The real party in interest for the Subject Application is The Procter & Gamble Company of Cincinnati, Ohio by virtue of the Assignment recorded on January 6, 2004, at Reel No. 014237, Frame 0136.

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RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences known to Appellants' undersigned legal representative, which will directly affect, or be directly affected by or have a bearing on, the Board's decision in the present appeal.

STATUS OF CLAIMS

In the Notice of Appeal, Appellants appealed the final rejections of pending Claims 1, 2, 10-12, 14, and 15. A complete copy of the appealed Claims is set forth in the Claims Appendix hereto.

Claims 1, 2, 10-12, 14, and 15 are pending in the Subject Application.

Claims 1, 2, 10-12, 14, and 15 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,960,272 to Hartbauer et al. and U.S. Patent No. 3,912,571 to Hartbauer et al. (together referred to herein as "Hartbauer")¹.

Claims 1, 2, 10-12, 14, and 15 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Hartbauer in view of U.S. Patent No. 6,924,042 to Von Paleske ("Von Paleske").

Claims 3-9, 13, and 16-27 have been previously cancelled without disclaimer or prejudice.

STATUS OF THE AMENDMENTS

No amendments to the instant claims have been filed by Appellants since January 4, 2010. All amendments in the Subject Application have been entered.

SUMMARY OF THE CLAIMED SUBJECT MATTER

Independent Claim 1 claims a rolled multi-ply product (see e.g., Specification, page 5, lines 15-16, and Fig. 1C) comprising a first fibrous structure ply and a second

¹ U.S. Patent No. 3,960,272 to Hartbauer et al. is a divisional application of U.S. Patent No. 3,912,571 to Hartbauer et al. For purposes of this Appeal Brief, all references will be made to U.S. Patent No. 3,960,272, as both references have a substantially common specification.

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fibrous structure ply that are ply bonded together to form a multi-ply fibrous structure having a core end and a tail (see e.g., Specification, page 5, lines 5-14, and Fig. 1C). The tail is bound to another portion of the multi-ply product by a tail seal glue (see e.g., Specification, page 6, lines 12-14, and Fig. 1C). The tail comprises a tail end (see e.g., Specification, page 5, lines 13-14). The tail of the multi-ply fibrous structure comprises a consumer accessible tab comprising the first fibrous structure ply and the second fibrous structure ply bonded together (see e.g., Specification, page 5, lines 19-24, and Figs. 1A-1C). At least a portion of the consumer accessible tab that is accessible to a consumer is positioned between the tail end of the multi-ply fibrous structure and the tail seal glue (see e.g., Fig 1C).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Appellants respectfully request review of the final rejection of Claims 1, 2, 10-12, 14, and 15 under 35 U.S.C. § 103(a) as being unpatentable over Hartbauer.

Appellants further respectfully request review of the final rejection of Claims 1, 2, 10-12, 14, and 15 under 35 U.S.C. § 103(a) as being unpatentable over Hartbauer in view of Von Paleske.

ARGUMENT

As discussed in greater detail below, the Appellants respectfully submit that Claims 1, 2, 10-12, 14, and 15 are patentable over the references relied upon in the Final Rejection, whether taken alone or in combination. Therefore, Appellants respectfully request reversal of the Final Rejection and allowance of Claims 1, 2, 10-12, 14, and 15. All of the rejections in the Final Rejection are respectfully traversed by Appellants.

A. Relevant Law

It is Office policy to follow *Graham v. John Deere Co.*, 383 U.S. 1; 148 U.S.P.Q. 459 (1966), in the consideration and determination of obviousness under 35 U.S.C. § 103. See *MPEP* § 2141. A determination of obviousness under § 103 requires the

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determination of the following factual inquiries: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; (3) resolving the level of ordinary skill in the pertinent art; and (4) evaluating evidence of secondary considerations, if any. Further, “[*a*ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385; 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970), see also, *MPEP* § 2143.03 (emphasis added). Further still, in formulating a rejection under § 103(a), the Office must identify in an Office Action a rational basis why a person of ordinary skill in the art would have combined or modified the prior art elements in the manner claimed. See *MPEP* § 2141; *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418; 82 U.S.P.Q.2d 1385 (2007) (hereinafter “*KSR*”) (a patent examiner must provide “an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate this review, this analysis should be made explicit.”; *In re Kahn*, 441 F.3d 977, 988; 78 U.S.P.Q.2d 1329 (Fed. Cir. 2006) (cited with approval in *KSR*) (“[R]jections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”))

In *KSR*, all elements of the claims were present in the prior art. In discussing the District Court's analysis, the Supreme Court in *KSR* stated:

Following *Graham's* direction, the court compared the teachings of the prior art to the claims of Engelgau. It found “little difference.” 298 F.2d at 590. Asano taught everything contained in claim 4 except the use of a sensor to detect the pedal's position and transmit it to the computer controlling the throttle. That additional aspect was revealed in sources such as the '068 patent and the sensors used by Chevrolet.

As such, the Supreme Court in *KSR* only considered what analysis was proper in making a combination of known prior art elements (i.e., *all elements* were provided in the prior art). The *KSR* Court did not overrule the “all elements” rule in a 35 U.S.C. § 103

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context. Therefore, in order to establish a *prima facie* case of obviousness and make a legally sufficient obviousness rejection, Appellants respectfully submit that an Examiner still has the burden of establishing that all elements of a claim are found in the prior art.

Further, in two recent post-*KSR* cases, the United States Court of Appeals for the Federal Circuit applied the ***all elements rule*** when considering obviousness and, only after the all elements rule was satisfied, determined if there was a motivation to combine the known prior art elements using the analysis set forth in *KSR*. See *Ball Aerosol and Specialty Container, Inc. v. Limited Brands, Inc.*, 555 F.3d 984; 89 U.S.P.Q.2d 1870 (2009) and *Fresenius USA, Inc. v. Baxter International, Inc.*, 2009 U.S. App. LEXIS 20155; 92 U.S.P.Q.2d 1163 (Fed. Cir. 2009). Accordingly, a legally sufficient examination of the pending claims of the Subject Application requires that the Examiner first locate ***all of the elements*** in the prior art and then, only if all elements are located, conduct an analysis to determine if the known elements can legally be combined using the guidelines provided by *KSR*. Further, it remains appropriate for a *post-KSR* court considering obviousness to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. *Fresenius USA, Inc. v. Baxter International, Inc.*, 2009 U.S. App. LEXIS 20155; 92 U.S.P.Q. 2D 1163 (Fed. Cir. 2009). In a recent case, the Federal Circuit stated that “[a] patent composed of several elements is not proved obvious merely by demonstrating that ***each of its elements*** was, independently, known in the prior art.” *In re Richard P. Mettke*, 570 F.3d 1356, 1360 (Fed. Cir. 2009) citing *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. at 418 (emphasis added). Additionally, in determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 U.S.P.Q. 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 U.S.P.Q. 698 (Fed. Cir. 1983); and *MPEP* § 2141.02(I).

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B. Independent Claim 1 is Not Rendered Obvious by Hartbauer Itself, or by Hartbauer in View of Von Paleske

Independent Claim 1 recites:

A rolled multi-ply product comprising a first fibrous structure ply and a second fibrous structure ply that are ply bonded together to form a multi-ply fibrous structure having a core end and a tail, which is bound to another portion of the multi-ply product by a tail seal glue, wherein the tail comprises a tail end, wherein the tail of the multi-ply fibrous structure further comprises a consumer accessible tab comprising the first fibrous structure ply and the second fibrous structure ply bonded together wherein at least a portion of *the consumer accessible tab that is accessible to a consumer is positioned between the tail end of the multi-ply fibrous structure and the tail seal glue.* (Emphasis added.)

1. Neither Hartbauer Itself, nor Hartbauer in view of Von Paleske, Discloses, Teaches, and/or Suggests All Elements of Claim 1

Neither Hartbauer itself, nor Hartbauer in view of Von Paleske, discloses, teaches, and/or suggests all elements of Claim 1. More specifically, neither Hartbauer itself, nor Hartbauer in view of Von Paleske, discloses, teaches, and/or suggests “a portion of the consumer accessible tab that is accessible to a consumer is positioned between the tail end of the multi-ply fibrous structure and the tail seal glue,” as recited in Claim 1. The “tail end” is defined in Appellants’ specification, for example, as elements 16 and 16” (see e.g., Figs. 1A-2C). The “tail end” of Hartbauer is illustrated below. Element 310 of Hartbauer is an adhesive dot. As can be seen from the illustration, the “tab” of Hartbauer is not positioned between the tail end of the tissue and the tail seal glue (310) and, therefore, Hartbauer does not disclose, teach, and/or suggest all elements of Claim 1, as required by *KSR*. The rejection of Claim 1 over Hartbauer in view of Von Paleske suffers from the same deficiencies. Therefore, Appellants respectfully request reversal of the final rejections of Claim 1, and the claims depending therefrom.

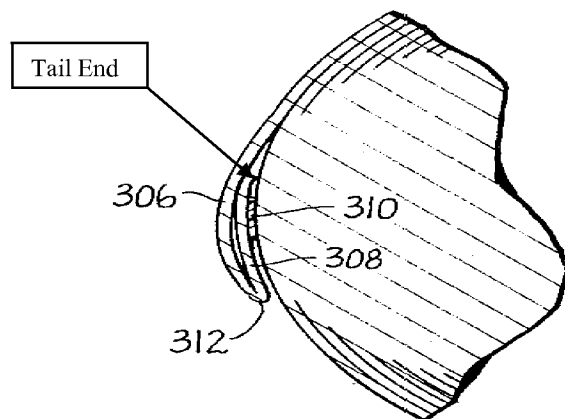


FIG. 12.

2. Neither Hartbauer Itself, nor Hartbauer in view of Von Paleske, Renders Claim 1 Obvious
 - a. The Final Rejection's Apparent Reasons are Legally Insufficient

The Final Rejection states on page 3 that “[a]ccordingly, the teaching of Hartbauer would have rendered obvious the invention as claimed in present claims 1-2, 10, 12 and 14 15” and states on page 4 that “[t]herefore, it would have been obvious to one of ordinary skill in this art, at the time the invention was made to use as the multi-ply fibrous product of Hartbauer, a multi-ply fibrous product of the type taught by Von Paleske and as known in this art, namely, a multi-ply fibrous product wherein the first ply and the second ply are bonded together.” The question that needs to be answered by the Final Rejection is “why” a person of ordinary skill in the art would be motivated to modify Hartbauer to arrive at the claimed invention and/or combine Hartbauer with Von Paleske to arrive at the claimed invention. This question has not been answered by the Final Rejection. Therefore, Appellants respectfully

submit that the Final Rejection has not provided a legally sufficient apparent reason to form the obviousness rejection. In fact, because the Final Rejection does not provide a legally sufficient apparent reason, Appellants respectfully submit that the rejections in the Final Rejection were solely based on impermissible hindsight in view of the Subject Application's disclosure. To reach a proper determination under 35 U.S.C. § 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. See *MPEP* § 2142.

Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight **must be avoided** and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. See *MPEP* § 2142. (Emphasis added.) Therefore, Appellants respectfully request reversal of the final rejections of Claim 1, and the claims depending therefrom.

b. Hartbauer Teaches Away from the Subject Application

Clearly, Hartbauer teaches folding the tail portion of the tissue back over an adjacent portion of the tissue (see Hartbauer, Figs. 11-15). Accordingly, a fold is required to be made in the tissue of Hartbauer (see col. 2, lines 40-60). Appellants' invention, however, eliminates the requirement that a fold be made in the tissue (see illustration below), thereby simplifying the manufacturing process by eliminating the folding step. In this instance,

Hartbauer's folding instructions expressly teach away from the teachings of the Subject Application.

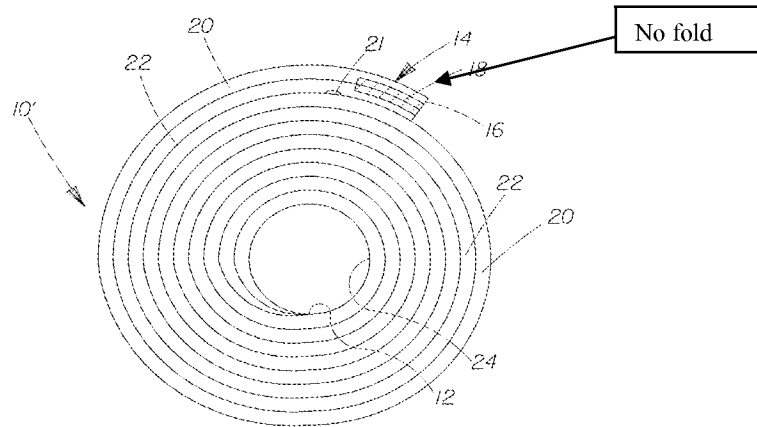


Fig. 1C

Further to the above, by not placing a fold in the tail 14, for example, the product of the Subject Application does not have a consumer accessible tab 18 that extends radially outwardly from the non-tail portions of the roll 10'. On the contrary, Hartbauer expressly teaches that "the free end of the tail portion is spaced from a wound portion of the roll product." Hartbauer, col. 2, lines 49-51. This teaching of Hartbauer is completely contrary to the teachings of the Subject Application.

In view of the above, Appellants respectfully submit that Hartbauer cannot be used in a 35 U.S.C. § 103 rejection of Claim 1, as Hartbauer expressly teaches away from the discovery of Appellants' invention, namely, a consumer accessible tab that does not require any folding operation and that does not extend radially outward from other non-tail portions of the roll. Therefore, Appellants respectfully request reversal of the final rejections of Claim 1, and the claims depending therefrom.

c. The Subject Application Eliminates Waste

The “tab” of Hartbauer requires a folded over portion, as discussed above. This folded over portion is not useful to the consumer and is likely wasted during use, leading to the increased creation of waste. The consumer accessible tab of the Subject Application, however, allows a consumer to have full use of a first sheet of tissue, thereby reducing waste. Although one could argue that this folded over portion occurs in only one sheet of each roll, when millions of rolls are produced, as is normally the case, this can lead to a significant amount of waste. As such, Appellants’ invention improves the prior art. Therefore, Appellants respectfully request reversal of the final rejections of Claim 1, and the claims depending therefrom, in view of the advantages achieved by the claimed invention over the prior art.

d. The Final Rejection’s Argument Regarding *MPEP* § 2144.04 Fails

The Final Rejection asserts on page 2 that “the change in location of the consumer accessible tab within the same general location as the prior art tab and performing the same function as the prior art tab constitutes no more than an unpatentable rearrangement of parts. See *MPEP* 2144.04.” Appellants respectfully disagree with the Final Rejection’s position that the claimed invention is merely a rearrangement of parts in the prior art. Appellants respectfully submit that *MPEP* § 2144.04 also states that “the mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant’s specification, to make the necessary changes in the reference device.” *Ex parte Chicago Rawhide Mfg. Co.*, 223 U.S.P.Q. 351, 353 (Bd. Pat. App. & Inter. 1984). Appellants respectfully submit that neither Hartbauer nor the Final Rejection provide a motivation or an apparent reason to rearrange its parts to arrive at the claimed invention of the Subject Application. Further, Appellants respectfully submit that Hartbauer’s fold cannot be properly rearranged to arrive at the claimed invention. Additionally, Appellants respectfully submit that there has been a

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long felt, unmet need for the claimed invention, even in the light of Hartbauer, which has been in the art for over 34 years. Furthermore, Appellants respectfully submit that the claimed invention addresses and solves this long felt, unmet need. Therefore, Appellants respectfully request reversal of the final rejections of Claim 1, and the claims depending therefrom.

C. Neither Hartbauer Itself, nor Hartbauer in view of Von Paleske, Discloses, Teaches, and/or Suggests All Elements of Claim 2

Dependent Claim 2 recites, in part, “the multi-ply fibrous structure is freely, convolutedly wound from the core end out to the tail end to form the rolled multi-ply product.” The tail end of Hartbauer is illustrated on page 7 of this Appeal Brief. Clearly, the tail end of Hartbauer is not “wound from the core end *out to the tail end*.” On the contrary, the tail end of Hartbauer is folded under the sheet comprising the tail end of the roll. The Subject Application’s winding of the product from the core end out to the tail end is illustrated above in Fig. 1C on page 9 of this Appeal Brief. As a result, Appellants respectfully submit that the Office Action does not provide all elements of Claim 2 and, therefore, respectfully request reversal of the final rejections of Claim 2.

D. Neither Hartbauer Itself, nor Hartbauer in view of Von Paleske, Discloses, Teaches, and/or Suggests All Elements of Claim 10

Dependent Claim 10 recites, in part, “the consumer accessible tab extends from the tail end of the multi-ply fibrous structure along the multi-ply fibrous structure towards the core end of the multi-ply fibrous structure.” The tail end of Hartbauer is illustrated above on page 7 of this Appeal Brief. The “tab” of Hartbauer initially travels from the tail end in a direction opposite the core end, which is inconsistent with the claimed recitation of Claim 10 of “the consumer accessible tab extends from the tail end....toward the core end.” While it may be argued that a portion of the “tab” of Hartbauer may extend toward the core end, this portion, however, does not extend from the tail end.

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As a result, Appellants respectfully submit that the Office Action does not provide all elements of Claim 10 and, therefore, respectfully request reversal of the final rejections of Claim 10.

E. Neither Hartbauer Itself, nor Hartbauer in view of Von Paleske, Discloses, Teaches, and/or Suggests All Elements of Claim 11

A similar argument as discussed above in section D, applies to dependent Claim 11. As a result, Appellants respectfully submit that the Office Action does not provide all elements of Claim 11 and, therefore, respectfully request reversal of the final rejections of Claim 11.

SUMMARY

For the reasons stated above, the Board is respectfully requested to find Claim 1, and the claims depending therefrom, allowable over the references cited by the Final Rejection.

Please direct any questions to the undersigned.

Respectfully submitted,

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CLAIMS APPENDIX

1. (Rejected) A rolled multi-ply product comprising a first fibrous structure ply and a second fibrous structure ply that are ply bonded together to form a multi-ply fibrous structure having a core end and a tail, which is bound to another portion of the multi-ply product by a tail seal glue, wherein the tail comprises a tail end, wherein the tail of the multi-ply fibrous structure further comprises a consumer accessible tab comprising the first fibrous structure ply and the second fibrous structure ply bonded together wherein at least a portion of the consumer accessible tab that is accessible to a consumer is positioned between the tail end of the multi-ply fibrous structure and the tail seal glue.
2. (Rejected) The multi-ply product according to Claim 1 wherein the multi-ply fibrous structure is freely, convolutely wound from the core end out to the tail end to form the rolled multi-ply product.
- 3-9. (Cancelled)
10. (Rejected) The multi-ply product according to Claim 1 wherein the consumer accessible tab extends from the tail end of the multi-ply fibrous structure along the multi-ply fibrous structure towards the core end of the multi-ply fibrous structure.
11. (Rejected) The multi-ply product according to Claim 1 wherein the consumer accessible tab extends from about the tail end of the multi-ply fibrous structure along the multi-ply fibrous structure towards the core end of the multi-ply fibrous structure.
12. (Rejected) The multi-ply product according to Claim 1 wherein at least the first and second fibrous structure plies of the multi-ply fibrous structure are bonded together by mechanical and/or chemical and/or electrostatic forces.

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13. (Cancelled)

14. (Rejected) The multi-ply product according to Claim 1 wherein the multi-ply fibrous structure consists of two plies of a fibrous structure.

15. (Rejected) The multi-ply product according to Claim 1 wherein the multi-ply product comprises a sanitary tissue product.

16-27. (Cancelled)

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EVIDENCE APPENDIX

None

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RELATED PROCEEDINGS APPENDIX

None